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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/357,957	07/21/1999	RICHARD LEVY	01064.0011-0	9917

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EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/22/2002

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 15

Application Number: 09/357,957
Filing Date: July 21, 1999
Appellant(s): LEVY, RICHARD

Attorney Robert J. Eichelburg
For Appellant

EXAMINER'S ANSWER

MAILED

MAY 23 2002

GROUP 1700

This is in response to the appeal brief filed March 19, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Appellants' arguments presented in the Appeal Brief, Paper No. 14, dated March 10, 2002, are convincing and the Examiner withdraws all the 35 USC 112 first and second paragraph rejections of all of the claims under the section titled (6) **ISSUES PRESENTED AS ITEMS 1. AND 2. AT PAGE 4 OF THE INSTANT** appeal Brief. The **ISSUES** presented as items 1. and 2. on page 4 of the Appeal Brief are deemed to be moot and are no longer considered to be under appeal.

(7) Grouping of Claims

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Appellant's brief includes a statement that claims 29-43 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

3,336,225	SAYAD et al	08-1967
4,525,527	TAKEDA et al	06-1985
4,552,938	MIKITA et al	11-1985
4,612,250	TAKEDA et al	09-1986
4,618,631	TAKEDA et al	10-1986
4,654,393	MIKITA et al	03-1987
4,677,174	ALEXANDER et al	06-1987
5,362,766	HOPKINS et al	11-1994
5,534,304	GEURSEN et al	07-1996
4,703,067	MIKITA et al	10-1987
4,983,389	LEVY	01-1991
4,985,251	LEVY	01-1991
WO 93/18223	GEURSEN et al	09-1993

Booser, Richard E., Ph.D., "Theory and Practice of Tribology", CRC Handbook of Lubrication, Vol. II Theory and Designs, 1984, pp. 46-56, 301-315, 329, 333 and 525-530.

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Brannon-Peppas, "Lisa Absorbent Polymer Technology" Studies in Polymer Science 8, 1990, pp. 3-55, 126-129, 142-143, 202-205, 223-247.

Buchholz, Fredric L. "Superabsorbent Polymers" Science and Technology, 1994, pp. 27-38 and 88-141.

Schey, John A. "Friction, Lubrication and Wear" Tribology in Metalworking, 1983, pp.131-179, 431-436, 465-470 and 487-503.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 29, 35 and 42 are rejected under 35 U.S.C. 102 (b). This rejection is set forth in prior Office Action, Paper No. 10 dated July 05, 2001.

Claims 29, 35-36 and 41-43 are rejected under 35 U.S.C. 103 (a). This rejection is set forth in prior Office Action, Paper No. Paper No. 10 dated July 05, 2001.

Claims 30-34 and 37-40 are rejected under 35 U.S.C. 103 (a). This rejection is set forth in prior Office Action, Paper No. 10 dated July 05, 2001.

Claims 29-43 are rejected under the judicially created doctrine of obviousness-type double patenting rejection. This rejection is set forth in prior Office Action, Paper No. 10 dated July 05, 2001.

(11) Response to Argument

In response to applicant's argument that neither Levy nor Brannon-Peppas teach appellant's claimed invention of claim 29, 35 or 42, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would

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otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

A careful reading of appellants instant claims indicate that the claims only require that said material for decreasing friction **optionally contains a lubricant additive wherein said additive is an** oxidant, rust inhibitor, anti-wear compound, extreme pressure additive, detergent, dispersant, pour point depressant, viscosity-index improver, or foam inhibitor. It is the examiner's position that the lubricant additive is not required and said lubricant additive is only an **optionally additive**. Appellants' arguments set forth on pages 9-10 of the Appeal Brief is not convincing. It appears that appellants claiming a different use for an old composition. Thus claims 29,35 and 42 are anticipated by the teachings of Admitted Prior Art, Levy 4,985,251 combined with Brannon-Pappas.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It appears that appellants have failed to appreciate that the rejection is based on combinations of references. The primary references teaching the basis lubricants composition with lubricant additives and the Admitted Prior Art as disclosed on pages 22-23 of the instant application, including Levy, '251 and '389, Brannon-Peppas and Buchholz teach that the instant claimed superabsorbent polymers (SAP) are old and

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conventional. Levy teachings are set forth above and repeated herein. Patentee teaches a composition comprising water, a polymer that absorbs greater than 100 times its weight in water (SuperSorb) and Arouf MSF (fatty acid esters, ethers, and alcohols) that functions as a film forming agent, as a surfactant emulsifier, or as an insecticidal, note column 17, lines 42-54. Water is a universal well-known lubricant that that is known to reduce friction in the lubricant art. Appellants make such admission on record at lines 11-12 of page 2 of the instant application. Appellants further make admission on record at pages 22-23 that admitted prior art, Brannon-Peppas, SAP are the SAP of the instant application. Brannon-Peppas teach that their SAP are well-known and commercially available as well as their chemical and physical properties including their ability to absorb greater than 100 times its weight in water, note page 245. The admitted prior art and the secondary references provide the teachings to substitute the polymers of the secondary references in the composition of the primary reference with the reasonable expectation that the substitution will provide the primary reference with a polymer that will absorb greater than 100 times its weight in water.

In response to applicant's argument that Hopkins fails to teach a utility for the combination of SAP and matrix, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

It appears that appellants have failed to appreciate that the rejection is based on combinations of references. Hopkins is maintained for its teaching for a composition

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comprising a matrix of cellulose acetate, glycerine and a SAP (SANWET) a starched grafted polyacrylate sodium salt that has the capacity to absorb as much as 800 times its own weight in liquid, note Example 1, claims 1-3, abstract, column 1, line 29 to column 2, lines 1-33. Not only does this composition include the composition of the instant claims it includes the composition of the primary reference of Sayad and therefore is not considered as non-analogous art because SAP and lubricant solutions are the same.

In response to applicant's argument that Hopkins fails to teach anything about the formation of a lubricant or the use of the disclosed material for the purpose of lubrication is non-analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, for the reasons set forth supra and not repeated Hopkins is not considered as non-analogous art since appellants claims are so broad that the teachings of Hopkins encompass the instant claims when combined as set forth in the 103 rejection made of record in Paper No. 10 dated July 05, 2001.

In response to applicant's argument that Geuersen does not teach or suggest SAP that can absorb greater than 100 times their weight in water for the process or product disclosed, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for

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patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Geuersen "263 teaches a water-in-oil, column 6, lines 23-24, comprising a SAP, column 6, lines 5-end, and provides for the further inclusion of lubricants and conventional additives, page 7, line 6 to page 8, line 17 and page 16, line 25 to page 17, line 12.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the swell value of the substrate containing a SAP that appellants refer to the data in columns 9 and 10.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to appellants arguments stated at pages 16 and 17 of the appeal brief that Geursen does not contain an enabling disclosure and that the examiner have refused to acknowledge this point and the analysis of Geursen as interpreted by appellants. Appellants are reminded that a reference must be considered in its entirety. It is noted at the paragraph bridging pages 12-13 of German that there is a clear teaching that patentee envisioned SAP that absorbs greater than 100 times its weight in water with teachings that swelling value ranges from 50 to 700 or higher based on the nature of the SAP. This particular teaching of Geursen clearly rebuts appellants' arguments and analysis of Geursen set forth on pages 14-17 of the Appeal Brief.

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In response to applicant's argument that Schey and Booser only elaborate on the description of the lubricant materials that appellant included in the written description on page 18 of the instant application, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

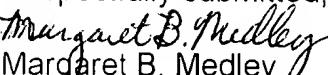
The secondary references Schey, pages 179, 431-436, 465-470 and 487-503 and Booser, pages 47-56, 269, 301-314, 329, 333, 525 and 529-530 teaches the specific lubricants and friction lubricant additives used in metalworking, for friction, lubrication and wear properties including synthetic and hydrocarbon oils, and greases thereof, waters, solid lubricants (organic and inorganic alone or mixtures thereof), phosphates, soap, water with solids or oils or greases thereof, fatty oils, acids or waxes thereof with other conventional lubricant additives. It is noted that appellants have indicated that these lubricants and friction additives are prior art knowledge and have made admission on record at pages 1-18 of the instant application.

Appellants comments directed to the double patent rejection has been reviewed and considered. The examiner has reviewed the M.P.E.P. Section 804(1.0(B) p.80019 dated August 2001. The double patent rejection is maintained since it is not the only rejection remaining in this application.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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Primary Examiner
Art Unit 1714

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May 19, 2002

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